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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/848,437	05/04/2001	Tim W. Blair	2222.038000H	7818
26111	7590	03/29/2006	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX PLLC 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			PHAM, KHANH B	
			ART UNIT	PAPER NUMBER
			2166	
DATE MAILED: 03/29/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/848,437

Applicant(s)

BLAIR ET AL.

Examiner

Khanh B. Pham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-90 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-90 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 January 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The formal drawings filed January 4, 2006 have been received. These drawings are accepted by the examiner.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 77-90 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 77-90 recite "a device" but none of the elements of the claimed device necessarily implemented in hardware. The claimed devices comprise only logic and are directed to an arrangement of software, per se, Claims 77-90 are therefore rejected as not being tangible.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

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applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. **Claims 21-90** are rejected under 35 U.S.C. 102(e) as being anticipated by Unger (US 5,721,910 A), hereinafter "Unger".

As per claim 21, Unger teaches a method of enabling a user to organize and analyze information comprising:

- "searching an input first group of documents to output a second group of documents" at Col. 3 lines 8-20;

(Unger teaches the step of using predefined search criteria to disaggregate a set of documents into discrete technical categories (i.e., "second group"))

- "analyzing an input third group of documents according to one or more analytical functions to output a fourth group of documents" at Col. 6 lines 25-55.

(Unger teaches the stored analysis may be used to analyze documents and identify a set of documents of particular interest for a particular application)

- "selectively iterating at least one of the searching and at least one of the analyzing, wherein each iteration of the searching or the analyzing is performed using as the input one of the second group, the fourth group, or the output of a previous iteration" at Col. 3 lines 55-59 and Col. .

(Unger teaches the step of further searching one or more categories (i.e., "second group") to identify a subset of

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documents. Unger also teaches the set of analyzed patents and/or technical documents (i.e., "fourth group") may then be used to identify trends(i.e., analyzing).

As per claim 22, Unger teaches the method of claim 21, further comprising:
"making at least one of the second group or the fourth group a permanent group" at Col. 3lines 45-50.

As per claim 23, Unger teaches the method of claim 21, wherein the searching comprises: "performing a cluster analysis of the first group of documents to create a hierarchical arrangement of groups containing documents from the first group, wherein the second group is one of the hierarchical arrangement of groups" at Col. 5 lines 35-63.

As per claim 24, Unger teaches the method of claim 21, further comprise
"performing a relevancy visualization analysis of one of the first group and the third group to identify how documents contained therein are inter-related with respect to key terms" at Col. 7 lines 5-25.

As per claim 25, Unger teaches the method of claim 24, wherein "relevancy visualization analysis operates according to a rule book" at Col. 5 lines 15-35.

As per claim 26, Unger teaches the method of claim 25, wherein the rule book comprises patent specific rule" at Col. 5 lines 15-35.

As per claim 27, Unger teaches the method of claim 21, further comprising:
"generating an object corresponding to a search process component or an analyze

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process component of a work flow represented by the searching, the analyzing, and selective iterating" at Col. 7 line 25 to Col. 8 line 50.

As per claim 28, Unger teaches the method of claim 27, wherein an object is generated using object definition" at Col. 8 lines 35-50.

As per claim 29, Unger teaches the method of claim 28, wherein the object definition comprise: "a Boolean operation object definition, a corporate family operating object definition; an export object definition; a folder object definition; an import object definition; a list exploder operation object definition; a list object definition; a query object definition; or a patent family dedupe object definition" at Col. 8 lines 35-50.

As per claim 30, teaches the method of claim 27, further comprising: "saving the at least one object" at Col. 7 lines 25-50.

As per claim 31, teaches the method of claim 27, further comprising: "re-executing the work flow by traversing the at least one object" at Col. 8 lines 50-62.

As per claim 32, Unger teaches the method of claim 27, further comprising: "creating a new work flow by modifying the at least one object" at Col. 8 lines 50-62.

As per claim 33, Unger teaches the method of claim 21, further comprising: "annotating at least one of the first group, third group, or any portion of any document contained in the first group or the third group" at Col. 4 lines 50-57.

As per claim 34, Unger teaches the method of claim 21, wherein the initial group of documents is from at least one of a database, an external source, or the Internet"-at Col. 4 lines 1-2.

Claims 35-90 recite a method, system, computer program product, and a device for performing similar method as in claims 21-34. Claims 35-90 are therefore rejected by the same reasons discussed above.

Response to Arguments

5. Applicant's arguments filed January 4, 2006 have been fully considered but they are not persuasive. The examiner respectfully traverses applicant's arguments.

Regarding the §101 rejection to claims 77-90, applicants requested clarification as to why the logic recited in the device claims 77-90 is software per se, and cannot read on hardware logic. The examiner respectfully submits that applicant's specification does not disclose the claimed logic is hardware logic, but instead defines logic as "computer software" at [0044] and "computer programs" at [0048]. In view of applicant's specification, the claimed device is therefore comprises only software components and therefore rejected as being intangible.

Applicant's argument regarding the §101 rejection to claims 21-48 is considered and the §101 rejection to claims 21-48 has been withdrawn.

In response to applicants' argument that Unger does not teach or suggest "selectively iterating at least one of the searching and at least one of the analyzing, wherein each iteration of the searching or the analyzing is performed using as the input one of the second group, the fourth group, or the output of a previous iteration", the examiner respectfully submits that Unger teaches the step of using predefined search

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protocol to identify a set of documents at Col 3 lines 9-15. The identified set of documents is further searched to identify a subset of documents (Col. 3 lines 55-60. This teaching is similar to applicant's method as shown in Fig. 30, where a set of documents 3004 is identified by the search 3002, and the search 3006 is further applied to the set 3004 to identify subset 3008. Unger therefore teaches the step of selectively iterating at least one of the searching using the second group as claimed.

Further, Unger also teaches selectively iterating at least one of the analyzing using as input the output of a previous iteration at Col. 6 lines 25-40. Particularly, Unger teaches the step of analyzing documents in the database to produce a set of document:

"the database system allows patents and/or technical documents to be electronically captured and analyzed at a convenient time".

Unger then further teaches the analyzed set of documents is used again to analyze and identify trends:

"This set of analyzed patents and or/technical documents may then be used to identify trends an discontinuities in the overall pattern of research efforts represented by the set of patents or technical documents."

Applicants argued that "the output of one stage of Unger cannot be arbitrarily applied as an input to another state of Unger". On the contrary, Unger teaches at Col. 6 lines 35-40 that: "Stage V and the Parsed data from Stage III feed into Stage VI". Unger

therefore uses output of a previous stage as input of a next stage for further searching and analyzing to achieve higher level abstraction.

In light of the foregoing arguments, the 35 U.S.C 101 and 102 rejections are hereby sustained.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh B. Pham whose telephone number is (571) 272-4116. The examiner can normally be reached on Monday through Friday 7:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on (571) 272-3978. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Khanh B. Pham
Examiner
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March 20, 2006

A handwritten signature in black ink, appearing to read "KPham", with a horizontal line underneath.